

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

James Adair et al.

Serial No.: **09/954,443**

Filing Date: **September 17, 2001**

For: **Heat Seal Die And System And
Method For Portion Control Sized Packaging**

Examiner: **Thanh K. Truong**

Art Unit: **3721**

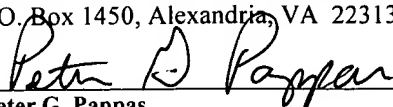
REPLY BRIEF

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Sir:

Pursuant to 37 C.F.R. §41.41, Applicants submit this Reply Brief in response to the Examiner's Answer mailed December 1, 2005 in Applicants' appeal of the Examiner's final rejection of all pending claims. Also submitted under separate cover is Applicants' Request For Oral Hearing under 37 C.F.R. §41.47 and the filing fee of \$1,000.00 as required by 37 C.F.R. §41.20(b)(3).

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Peter G. Pappas

Date: **January 31, 2006**

Application/Control Number: 09/954,443

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I. Status of Claims

Claims 9, 12-18, and 21-26 are pending for purposes of this appeal. Claims 1-8, 10 and 19-20 are cancelled. Claims 9, 12-18, and 21-26 are the subject of the Final Rejection mailed August 24, 2004 and the Advisory Action mailed March 3, 2005. This rejection of claims 9, 12-18, and 21-26 is appealed and allowance of all claims is respectfully requested.

II. Grounds of Rejection to be Reviewed on Appeal

On August 24, 2004, the Examiner issued a Final Rejection of all pending claims of the application under 35 U.S.C. §103(a). In particular, the Examiner rejected Claims 9, 12-18 and 21-26 as being unpatentable over U.S. Patent 3,228,170 issued to Eisenstadt (the Eisenstadt Patent) in view of U.S. Patent 6,301,859 issued to Nakamura et al. (the Nakamura Patent). The Examiner cited the Eisenstadt Patent as disclosing all features of independent claims 9 and 18 of the application except the use of heat tubes in the die members. The Examiner reasoned that it would have been obvious to one having ordinary skill in the art, at the time Applicants' invention was made, to modify the system disclosed in the Eisenstadt patent and incorporate the heat seal die as taught by the Nakamura patent providing an improved heat sealer effective to accomplish a uniform and proper temperature distribution in the seal contact faces to secure a sealing streak in the resulting seal.

A. Concise Statement of Each Ground of Rejection Presented for Review

Ground 1

Whether the cited prior art establishes a prima facie case of obviousness with regard to the rejected claims 9, 12-18, and 21-26.

Ground 2

Whether the invention described in claims 9, 12-18, and 21-26 would have been obvious over the cited prior art to one of ordinary skill in the art at the time such invention was made in view of the submitted evidence of secondary considerations.

III. Argument

A. The Nakamura Patent Teaches Away From Using Heat Tubes

The Examiner takes the position that the Nakamura patent does not teach away from using heat tubes (referred to as heat pipes in Nakamura) and describes where the Nakamura patent discloses the use of heat tubes in a prior art device. In the Examiner's Answer, the Examiner states that the Nakamura patent "simply emphasizes that the heat pipe is a better choice for heating the heat-sealing jaws in the lengthwise direction, but for the heating of the heat-sealing jaws in the radial direction, the heat conducting member (other than the heat pipe) such as the one discloses in the Nakamura present invention is more suitable." The critical teaching in the Nakamura patent, however, is in reporting the finding that a "heat pipe has not sufficient heat conductive characteristic in a radial direction" for use in heat sealing jaws. Col. 10, lines 10-20. Instead, the Nakamura patent teaches the uses of copper rods to distribute heat. The Nakamura patent clearly teaches away from the invention described in Applicants' claim 9 and 18.

The Examiner would have one of ordinary skill consider only the portion of the Nakamura patent describing the use of heat pipes in heat sealing jaws and apply that teaching to the Eisenstadt patent. However, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391 (CCPA 1965). The quote above has been cited in several cases, including *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), in which the court vacated a district court ruling that held a plaintiff's patent invalid for obviousness based on single line of a prior art reference. Basing the analysis on the single line and the teachings of the

plaintiff's patent was improper hindsight analysis. 796 F.2d at 448. The court pointed out that the district court had "failed to consider the [prior art] reference in its entirety and thereby ignored those portions of the reference that argued against obviousness", since the remainder of the reference taught away from the claimed invention. 796 F.2d at 448-49. The MPEP also states the following: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). MPEP § 2141.02. Taking into account the express teaching away in the Nakamura patent, there is no motivation to combine the Nakamura and Eisenstadt patents, much less a reasonable expectation of success in such a combination, and the Examiner's rejection should therefore be withdrawn as failing to establish a prima facie case of obviousness.

B. The Performance of Applicants' Claimed Invention is Surprising In View of The Nakamura Patent Teaching.

The Examiner takes the position that Applicants are trying to read portions of their specification into the claims in describing the benefits of using the technology of Applicants' claims 9 and 18 in multi-lane portion control packaging machinery, but Applicants' evidence is taken out of context by the Examiner. The Applicants instead demonstrate with evidence of record that the technology of Applicants' claims 9 and 18 performs surprisingly well in view of the teaching in the Nakamura patent that heat tubes are insufficient for use in heat seal dies.

C. The Combination of the Eisenstadt and Nakamura Patents is Improper Hindsight Reconstruction.

In addressing Applicants' argument that the combination of the Eisenstadt and Nakamura Patents is improper hindsight reconstruction, the Examiner raises the red herring of "nonanalogous art." This is not at issue. The prohibition against hindsight reconstruction applies to combinations of analogous references. The MPEP states the following: "To rely on a reference under 35 U.S.C. 103, it must be analogous prior art". MPEP § 2141.01(a). Additionally, the MPEP states that "[a]pplicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning." MPEP § 2145. Other cases recite the same limitations on hindsight reconstruction. "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. There must be 'something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543 (Fed. Cir. 1985). The problem with the combination of the Eisenstadt and Nakamura Patents is that the Nakamura Patent teaches away from such a combination.

D. Applicants' Objective Evidence of Nonobviousness Must Be Considered.

Applicants have submitted substantial evidence of nonobviousness in the Cigallio and Dougherty Declarations concerning lack of motivation to combine the Eisenstadt and Nakamura Patents, the lack of any reasonable likelihood of success in combining them, unexpected results of the technology described in Applicants' claims, a long felt but unsatisfied need solved by the technology described in Applicants' claims, the commercial success of the technology described

in Applicants' claims, licenses of the technology described in Applicants' claims, and replacement of prior art devices by the technology described in Applicants' claims.

The examiner is required to consider Rule 132 evidence. MPEP § 1504.03 states the following: "Any objective evidence of nonobviousness or rebuttal evidence submitted by applicant, including affidavits or declarations under 37 CFR 1.132, must be considered by examiners in determining patentability under 35 U.S.C. 103(a)." In addition, MPEP § 716.01(a) requires that objective evidence must be considered when timely presented. "Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that 'evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness.' MPEP § 2141 recites the same requirements.

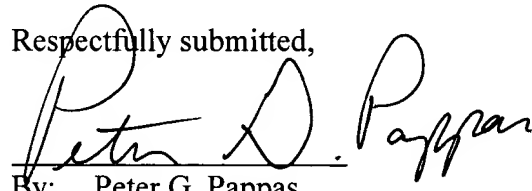
Applicants respectfully submit that the evidence of the non-obviousness of claims 9 and 18 is overwhelming, yet the Examiner has not yet provided any substantive reply to this evidence, much less provided any evidence to the contrary. The Examiner merely summarily concludes that the facts submitted in the Cigallio and Dougherty Declarations are "not germane to the rejection at issue. Applicants respectfully submit that the Cigallio and Dougherty Declarations are directly on point as is described in great detail in Applicants' Appeal Brief. Those arguments are not repeated here in detail, but Applicants respectfully request their careful consideration.

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In conclusion, the cited prior art does not establish a prima facie case of obviousness with regard to independent claims 9 and 18 of the application, and even if it did, Applicants' evidence of secondary considerations is overwhelming and warrants a finding of non-obviousness. Accordingly, all claims are allowable over the cited art and Applicants respectfully petition the Board to overrule the Examiner's final rejection and order the allowance of all claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter G. Pappas", is written over a horizontal line.

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Attorney Docket No.: 17244-0129